

Docket No. CAS1PAU24R2

Reissue Application

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Reissue of:

Sanchez et al.

Patent No.: 5,635,235

Date of Patent: June 3, 1997

Serial No.: 09/753,171

Filed: December 29, 2000

For: METHODS FOR HANDLING MASA

Examiner: Arthur L. Corbin

Group Art Unit: 1761

Irvine, California

AMENDED APPEAL BRIEF IN ACCORDANCE WITH 37 CFR § 1.192(d)

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In response to the Notification of Non-Compliance with 37 CFR §1.192(c), mailed on April 9, 2003, an Amended Appeal Brief is attached. The original Appeal Brief was submitted with the requisite fee under 37 CFR §1.17(c), and a one-month extension of time. It is believed that all required fees have been submitted or charged. If necessary, however, please charge Deposit Account No. 01-1960.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Box Reissue, Assistant Commissioner for Patents, Washington, DC 20231** on

April 29, 2003

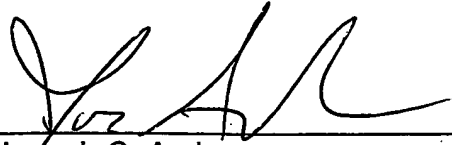
By Angela Williams



Signature

April 29, 2003

Respectfully submitted,



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AMENDED APPEAL BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

In accordance with the Notice of Appeal filed on November 21, 2002, appellant respectfully submits statements and arguments required by 37 CFR §1.192. The present appeal brief is submitted in triplicate.

(1) REAL PARTY IN INTEREST

Assignee Casa Herrera, Inc. is the real party in interest.

(2) RELATED APPEALS AND INTERFERENCES

No related Appeals or Interferences are pending.

(3) STATUS OF CLAIMS

Claims 1-37 were cancelled. Claims 38-57 are pending in this application, are finally rejected and are appealed.

(4) STATUS OF AMENDMENTS

No amendments were filed subsequent to final rejection.

(5) SUMMARY OF INVENTION

"Masa" is a term that generally describes flour dough used to make tortillas. The present invention, as defined in the claims involved in the appeal, and described in the specification on page 16 line 21 through page 19 as well as illustrated in Figs. 1 and 7, is directed to a method for feeding masa 74 to a pair of aligned, opposed sheeter rollers 56, the sheeter rollers located adjacent to a masa hopper 40 having an opening for receiving masa and a slot 116 for dispensing masa, the masa hopper 40 also having at least one shaft 52 above the slot 116, each shaft 52 having a projection, the method comprising the steps of: placing the masa 74 through the opening in the masa hopper; feeding the masa to at least one shaft 52; and forcing the masa through the slot 116, toward the sheeter rollers 56, with the projection 122 on at least one shaft.

The method further comprises the step of removing gas bubbles from the masa 74 with the projection 122 on at least one shaft 52. Additionally, the masa hopper 40 more specifically has a pair of opposed, horizontally aligned, primary rollers 54 between the slot 116 and the sheeter rollers 56, the primary rollers 54 each having a generally cylindrical surface and two ends. The method further comprises the steps of: rotating the primary rollers 54; drawing the masa 74 between the primary rollers 54; compressing the masa 74 into a generally uniform curtain; and feeding the uniform curtain into the sheeter rollers 56.

In the method there is additionally a scraper 130 for each primary roller 54, each scraper 130 having a blade 132 pivotally mounted and biased to longitudinally ride on the lower surface of its associated primary roller 54. Another step in the method is separating masa 74 from the lower surface of each of the primary rollers 54. Also, the masa hopper 40 has two endcaps 126, each endcap 126 mounted around the ends of the primary rollers 54. The method further prevents movement of the masa past the ends of the primary rollers.

(6) ISSUES

Issue #1:

Whether or not a reissue declaration from a parent reissue application may be used in a continuation reissue application that seeks to broaden claims based on a different error than noted in the parent declaration, where the parent declaration properly put the public on notice of broadening claims.

Issue #2:

Whether or not, in light of 35 U.S.C. §120, a continuation reissue application is properly regarded as a "separate" application that impermissibly broadens claims if filed outside the two-year statutory period of 35 U.S.C. §251.

(7) **GROUPING OF CLAIMS**

Claims 38-57 shall stand or fall together.

(8) **ARGUMENTS**

Issue #1 – The Reissue Declaration.

a. Procedural Summary.

On June 3, 1997, the Patent Office issued the applicants' patent no. 5,635,235. On June 3, 1999, the applicants filed a parent reissue application. In support of the parent application, each of the three inventors signed a Reissue Application Declaration (form PTO/SB/51). As provide by the PTO's form, the inventors broadly stated by checking the appropriate box that:

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reason described below. (check all boxes that apply):

/X/ by reason of the patentee claiming more or less than he had the right to claim in the patent.

The Reissue Application Declaration (form PTO/SB/51) also invited the inventors to describe "at least one error upon which reissue is based." (emphasis added) In that section, as requested, the inventors noted that:

The claims directed to a "Diverter Gate" are too narrow.

As required by 35 U.S.C. 251, therefore, the patentee notified the public within two years of the patent's issuance that it sought to broaden the claims of its patent.

On December 29, 2000, during the co-pendency of the parent application, the patentee filed a continuation reissue application to broaden other claims because it determined that it had claimed "less than it had the right to claim in the patent" in respect to areas other than as to the diverter gate. In particular, some of the claims required a hopper with a pair of side walls and a bottom wall and an infringer was asserting that its product does not infringe because it included a hopper that was created with a pair of slanted side walls and no bottom wall.

On December 29, 2000, the applicants could have simply continued to prosecute the parent application by filing a Continued Prosecution Application (CPA). In such case, the parent application's declarations would obviously have been compliant with 37 CFR 1.175(a)(1). Instead, however, the patentee elected to file a continuation application so that the parent application could issue without delay. On January 2, 2001, the parent application matured into Reissue Patent RE37,008.

As a result of that purely procedural step of choosing to issue the parent while filing a continuation, the Examiner asserts that the parent application's declarations are inadequate for use in the continuation application and that, regardless of the resolution of that issue, that the continuation application is a "separate" reissue application that 35 USC 251 prohibits from being broadened because it was filed outside the two-year statutory period.

The Final Office Action dated May 21, 2002 contends that this continuation application is defective because the error relied on to support this continuation

application does not comply with 37 CFR 1.175(a)(1). The first paragraph then refers applicant to the previous Office Action, where the Examiner contends that:

The error identified in the reissue declaration applies only to the parent reissue. A different error that applicant relies upon to support the instant continuation reissue application must be identified in a supplemental reissue declaration.

The prior Office Action, in other words, asserts that the continuation application cannot rely on the parent application because the error identified in the parent application's declarations is different that the error being addressed in this continuation application.

Applicants respectfully traverse.

b. Argument.

As to Issue #1, the Examiner contends that a parent reissue application declarations are defective for use in a continuation reissue application under 37 CFR §1.175 (a)(1), where the continuation reissue application seeks to broaden claims based on a different error than the "at least one" example noted in the parent declaration. 37 CFR §1.175 (a)(1) requires that a reissue oath or declaration in addition to complying with the requirements of §1.63, must also state that the patent is wholly or partly invalid by reason of a defective specification or drawing or:

by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue.

As invited by the PTO's own form, Reissue Application Declaration (form PTO/SB/51), each inventor broadly stated by checking the appropriate box that:

I verily believe the original patent to be wholly or partly inoperative or invalid, for the reason described below. (check all boxes that apply):

/X/ by reason of the patentee claiming more or less than he had the right to claim in the patent.

The Reissue Application Declaration also invited the inventors to describe "at least one error upon which reissue is based." (emphasis added) In that section, as requested, the inventors noted that:

The claims directed to a "Diverter Gate" are too narrow.

Claims at issue in this continuation application could have been supported by these broad declarations had the patentee added them to the parent application. This is the law as set forth in In re Doll.¹ In that case, the applicant presented broadening reissue claims 20-31 prior to the two-year period, submitting a supporting reissue declaration that stated that:

None of the patent claims afford for the embodiment of Fig. 4 patent coverage of the scope possessed by claims 20-31, inclusive, which form part of the foregoing specification, nor were claims of comparable scope ever presented during the pendency of the original application on which said Letter Patent were granted.²

Later, after more than two-years had passed since the patent issued, the appellant added even **broader** claims, not once, but twice. Like the Examiner here, the Patent Office contended that the In re Doll applicant's reissue oath was defective. The CCPA held, however, that even though the later filed reissue application claims were even broader than the first-filed reissue application claims 20-31, the ones explicitly referenced in the reissue declaration, the reissue declaration was sufficient to support

¹ 419 F.2d 925, 164 USPQ 218 (CCPA 1970).

² In re Doll, at 220.

all of the reissue application claims. Referring to the two year statutory period as set forth in 35 U.S.C. §251(4), the CCPA stated that:

It appears clear that the language 'applied for' refers to filing of [the reissue] application [and not to the submission date of the later added claims].³

In In re Paul Graff, the Federal Circuit discusses In re Doll. It notes that because "the public was placed on notice of the patentee's intention to enlarge the claim by the filing of a broadening reissue application within the two year statutory period. The court in Doll simply held that the reissue applicant, in the course of prosecution of the reissue application, was not barred from making further broadening in the claims."⁴ Therefore, additional broadening outside the two-year limit is appropriate as long as some broadening occurred within the two-year period.⁵ It is clear that the original reissue declaration met the objective of public notice of broadening reissue claims.

The only difference between this case and In re Doll is that instead of prosecuting one application for a long time while adding different claims along the way, the Patentee filed a continuation reissue application that claimed priority to an earlier-filed reissue application under 35 U.S.C. §120. This is purely a procedural choice and does not affect the legal rights of the patentee. In fact, 35 U.S.C. §251(2) specifically authorizes the Commissioner to issue several reissue patents. The Federal Circuit discusses §251(2) as "plainly intended as enabling, not limiting. Section 251(2) has the effect of assuring that a different burden is not placed on divisional or continuation reissue applications, compared with divisions and continuations of original applications,

³ 419 F.2d at 928, 164 U.S.P.Q. at 220.

⁴ In Re Paul Graff, 111 F.3d 874, 877 (Fed. Cir. 1997).

⁵ 62 FR 53132, 53154, citing In re Doll, 419 F.2d 925.

by codifying the Supreme Court decision which recognized that more than one patent can result from a reissue proceeding.”⁶

The Examiner contends that a continuing chain of reissue applications is contrary to the strong public policy intended to be enforced by 35 U.S.C. §251(4). To the contrary, the patentee respectfully asserts that in light of In re Doll, 35 U.S.C. §251(2), and In re Paul Graff, the law plainly allows a continuing chain of reissue applications so long as the first is filed within two years since the public policy behind the two-year statutory period is simply to place the public on notice within two years that broadening claims are being sought.

The Examiner also argues that the continuing reissue application broadens claims based on “new facts” that takes advantage of the “fortuitous” filing of the parent reissue application. How is the filing of Applicants’ parent application any more “fortuitous” than the parent application filed in In re Doll. The answer is: “it is not.” Under In re Doll and In re Paul Graff, continuation reissue applications are not more burdened than a continuation of an original application; and additional broadening outside the two-year limit is appropriate as long as some broadening occurred within the two-year period.

The Patentee respectfully submits that the parent declarations are adequate. Nonetheless, if the Board determines that new reissue declarations are required, the Patentee requests that it be given sufficient time to obtain such declarations from the non-cooperative inventors.

⁶ In re Paul Graff, 111 F.3d at 877.

Issue # 2 – A Continuation Reissue Application Is Not A “Separate”

Application

a. Procedural Summary.

Refer to the procedural summary for Issue #1.

b. Argument.

Regarding Issue #2, as stated above, In re Paul Graff makes clear that continuation reissue application is not a “separate” application. A continuation reissue application, like any other continuation application, is controlled by 35 USC §120 that provides in relevant part that:

An application for patent *** which is filed by an inventor or inventors named in the previously filed application shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application *** if it contains or is amended to contain a specific reference to the earlier filed application.

Therefore, a continuation reissue application, just like any other continuation application, is not legally “separate” from its parent application.

CONCLUSION

As discussed above, the Examiner’s rejection is premised on the misunderstanding that the facts here are distinguishable from In re Doll because here there is a continuation reissue application. However, In re Doll holds that a reissue oath is not defective when relied on for additional broadening outside two years as long as some broadening occurred within two years; and In re Paul Graff holds that section 251(2) assures that no different burden is placed on a continuation reissue application

compared with a continuation of an original application. Accordingly, it is respectfully requested that the Examiner's Final Action rejecting claims 38-57 be reversed.

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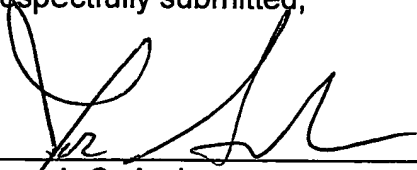
April 29, 2003

By Angela Williams


Signature

April 29, 2003

Respectfully submitted,


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APPENDIX

APPENDIX A

CLAIMS INVOLVED IN THE APPEAL

38. (Amended) A method for feeding masa to a pair of aligned, opposed sheeter rollers, the sheeter rollers located adjacent to a masa hopper having an opening for receiving masa and a slot for dispensing masa, the masa hopper also having at least one shaft above the slot, each shaft having a projection, the method comprising the steps of:

placing the masa through the opening in the masa hopper;

feeding the masa to at least one shaft; and

forcing the masa through the slot, toward the sheeter rollers, with the projection on at least one shaft.

39. The method for feeding masa defined in Claim 38 comprising the further step of removing gas bubbles from the masa with the projection on at least one shaft.

40. The method for feeding masa as defined in Claim 38, wherein said feeding is accomplished by gravity.

41. (Amended) The method for feeding masa as defined in Claim 38, wherein said forcing is accomplished by rotating the shaft with a motor.

42. (Amended) The method for feeding masa as defined in claim 38, wherein the masa hopper also has a pair of opposed, horizontally aligned, primary rollers between the slot and the sheeter rollers, the primary rollers each having a generally cylindrical surface and two ends, the method further comprising the steps of:

- rotating the primary rollers;
- drawing the masa between the primary rollers;
- compressing the masa into a generally uniform curtain; and
- feeding said uniform curtain into the sheeter rollers.

43. The method for feeding masa defined in Claim 42, wherein there is a scraper for each primary roller, each scraper having a blade pivotally mounted and biased to longitudinally ride on the lower surface of its associated primary roller, the method further comprising the step of:

- separating masa from the lower surface of each of the primary rollers.

44. (Amended) The method for feeding masa as defined in claim 42, wherein the masa hopper also has two endcaps, each endcap mounted around the ends of the primary rollers, the method further comprising the step of:

- preventing movement of the masa past the ends of the primary rollers.

45. (Amended) A method for feeding masa to a pair of aligned, opposed sheeter rollers, the sheeter rollers located adjacent to a masa hopper having an opening for receiving masa and a slot for dispensing masa, the masa hopper also having at least

one shaft above the slot, each shaft having a projection, the method comprising the steps of:

- placing the masa through the opening in the masa hopper;
- feeding the masa to at least one shaft; and
- removing gas bubbles from the masa with the projection on at least one shaft.

46. The method for feeding masa defined in Claim 45 comprising the further step of forcing the masa through the slot, toward the sheeting rollers, with the projection on at least one shaft.

47. The method for feeding masa as defined in Claim 45, wherein said feeding is accomplished by gravity.

48. (Amended) The method for feeding masa as defined in Claim 45, wherein said forcing is accomplished by rotating the shaft with a motor.

49. (Amended) The method for feeding masa as defined in claim 45, wherein the masa hopper also has a pair of opposed, horizontally aligned, primary rollers between the slot and the sheeting rollers, the primary rollers each having a generally cylindrical surface and two ends, the method further comprising the steps of:

- rotating the primary rollers;
- drawing the masa between the primary rollers;
- compressing the masa into a generally uniform curtain; and
- feeding said uniform curtain into the sheeting rollers.

50. The method for feeding masa defined in Claim 49, wherein there is a scraper for each primary roller, each scraper having a blade pivotally mounted and biased to longitudinally ride on the lower surface of its associated primary roller, the method further comprising the step of:

separating masa from the lower surface of each of the primary rollers.

51. (Amended) The method for feeding masa as defined in claim 49, wherein the masa hopper also has two endcaps, each endcap mounted around the ends of the primary rollers, the method further comprising the step of:

preventing movement of the masa past the ends of the primary rollers.

52. (Amended) A method for feeding masa to a pair of aligned, opposed sheeter rollers, the sheeter rollers located adjacent to a masa hopper having an opening for receiving masa and a slot for dispensing masa, the masa hopper also having at least one shaft above the slot, each shaft having a projection, the method comprising the steps of:

placing the masa through the opening in the masa hopper;

feeding the masa to at least one shaft;

removing gas bubbles from the masa with the projection on at least one shaft;

and

forcing the masa through the slot, toward the sheeter rollers, with the projection

on at least one shaft.

53. The method for feeding masa as defined in Claim 52, wherein said feeding is accomplished by gravity.

54. (Amended) The method for feeding masa as defined in Claim 52, wherein said forcing is accomplished by rotating the shaft with a motor.

55. (Amended) The method for feeding masa as defined in claim 52, wherein the masa hopper also has a pair of opposed, horizontally aligned, primary rollers between the slot and the sheeter rollers, the primary rollers each having a generally cylindrical surface and two ends, the method further comprising the steps of:

- rotating the primary rollers;
- drawing the masa between the primary rollers;
- compressing the masa into a generally uniform curtain; and
- feeding said uniform curtain into the sheeter rollers.

56. The method for feeding masa defined in Claim 55, wherein there is a scraper for each primary roller, each scraper having a blade pivotally mounted and biased to longitudinally ride on the lower surface of its associated primary roller, the method further comprising the step of:

- separating masa from the lower surface of each of the primary rollers.

57. (Amended) The method for feeding masa as defined in claim 55, wherein the masa hopper also has two endcaps, each endcap mounted around the ends of the primary rollers, the method further comprising the step of:

preventing movement of the masa past the ends of the primary rollers.

The official stamp of the PTO hereon
acknowledges receipt of:

Date: April 28, 2003
Reissue of Patent No.: 5,635,235
Date of Patent: June 3, 1997
Application No.: 09/753,171
Client: Casa Herrera, Inc.
For: METHOD FOR HANDLING MASA
Atty. Dkt. No.: CAS1PAU24R2

Enclosed:

1. Amended Appeal Brief In Accordance
With 37 CFR § 1.192(d) - (4) pages
2. Amended Appeal Brief (17 pages) -
(In Triplicate); and
4. Return postcard.

